UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,194	11/13/2000	Casey William Norman	1391-CIP-00	6427

35811 7590 03/05/2004

IP DEPARTMENT OF PIPER RUDNICK LLP
3400 TWO LOGAN SQUARE
18TH AND ARCH STREETS
PHILADELPHIA, PA 19103

EXAMINER	
WILLIAMS, JAMILA O	

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/711,194	NORMAN ET AL.	
	Examiner	Art Unit	
	Jamila O Williams	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *amendment filed 11-3-03*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-16 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-16 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11-3-03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,3-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-23,25-51 of copending Application No. 09/844322. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are similar in scope and subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuda. Yasuda discloses a seamless doll's skin or garment (fig 1) comprising a seamless, molded elastomeric material (column 3 lines 18-54 of the specification) adapted to be repeatedly dressed, fitted over and removed from a doll to transform the doll into a different character or object (inherently capable of this function); wherein the elastomeric material is a synthetic polymer, which is a copolymer consisting ethylene-vinyl acetate copolymer (column 3 lines 24-25).
5. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by'774 to Fogarty. Fogarty discloses a seamless doll's skin (70,80) comprising seamless, molded elastomeric material (column 4 lines 47-49 and 66-68, in that plastic materials encompass elastomeric properties, see fig 8) adapted to be repeatedly dressed, fitted over and removed from a doll to transform the doll into a different character or object (figs 11-13).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 6-11,13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda. Yasuda discloses all of the elements of the claims except for the modulus of elasticity, as recited in claims 6,13,14 and the adaptability of the garment to be used with dolls of a specific height range, as recited in claims 7-8,10 and form as recited in claim 9. In that the material of Yasuda is elastomeric, it inherently has a modulus of elasticity. It would have been obvious to one having ordinary skill in the art to construct the material of Yasuda to have the claimed modulus of elasticity for the purpose of providing better elastic properties or flexibility of the material. Regarding the limitation that the garment or skin is adapted to be used with a doll having a specific height range. It is old and well known to make dolls of various heights and sizes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material of Yasuda usable with dolls of varying height ranges. Regarding the skin having a specific form as recited in claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of Yasuda to form an animal since the material is disclosed to be used as fur of stuffed animal toys (column 19 lines 62).

Regarding the limitations of claims 13 where the applicant is claiming both a doll's skin and garment. It appears from the specification (page 4 line 20) that "the garment is a skin". Therefore the examiner maintains that Yasuda meets the requirements of the claim as stated above.

Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda in view of '774 to Fogarty. Yasuda discloses all of the elements of the claims as applied to claim 11 above. Yasuda does not, however, disclose the garment having at least one integrally molded detail. Fogarty teaches molded doll garments having integrally molded details (fig 4, 9). It would have been obvious to use the teaching of an integrally molded feature of Fogarty with the garments (doll clothes) of Yasuda for the purpose of making the garment more realistic.

8. Claims 3-5, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over '774 to Fogarty in view of Yasuda. Fogarty discloses all of the elements of the claims including molded elastomeric material used as a doll's skin, as applied to claim 1 above and the skin having the form of a cartoon character (cowgirl, princess). Fogarty does not however disclose the specifics of the material as recited in claims 3-5. Yasuda provides a teaching for a synthetic polymer which is a copolymer consisting of ethylene-vinyl acetate copolymer (column 3 lines 24-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of Yasuda with the skin of Fogarty for the purpose of providing more flexibility.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over '774 to Fogarty in view of Yasuda. Fogarty discloses a play set including a doll donned and fitted with a flexible plastic garment which removably encloses around at least a part of the doll and is adapted to be removed, dressed and refitted again to the doll (fig 9-13). Fogarty does not however specifically provide a teaching of a synthetic polymer

for the garment nor the height range for the doll. Yasuda discloses a material used for doll clothes (garments) including a synthetic polymer (column 3 lines 18-25 of the specification). It would have been obvious to use the material of Yasuda with the garments of Fogarty for the purpose of providing more flexibility. Regarding the height range of the dolls. It is old and well known to make dolls of different heights and sizes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the height of the doll as a matter of design choice and for the purpose of providing a more reasonably sized doll for different users.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over '774 to Fogarty in view of Yasuda and further in view of Gross. Fogarty and Yasuda disclose all of the elements of the claims as recited above. However a doll articulated at a joint, as recited in claim 16 is not disclosed. Gross teaches a doll articulated at the elbow and knee (see fig 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the joints of Gross with the doll and garments of Fogarty and Yasuda for the purpose of proving a more realistic play set for the user.

Response to Arguments

Applicant's arguments filed 11-3-03 have been fully considered but they are not persuasive.

Regarding the limitation of amended claim 1 including the wall thickness, the examiner notes that the references disclose all of the elements of the claims but for an express teaching of the wall thickness. However, on page 7 2nd paragraph of the

specification applicant gives no criticality to the wall thickness, in fact the applicant states that various thicknesses can be used. Additionally, based on the manner in which the clothing is supposed to fit (note for example fig 9 of Fogarty), the configuration of the clothing and/or the material construction of the clothing and/or the size of the doll it would have been obvious to one having ordinary skill in the art to make the clothing thickness from 1-3mm in order that it functions for the intended purpose.

Regarding the argument that Yasuda teaches a laminate with multiple layers inherently having seams. The examiner maintains the rejection, the "seamless" skin disclosed/claimed has nothing to do with the internal structure of the material (as not to exclude the laminate of Yasuda.

The arguments towards the modulus of elasticity are noted but are not convincing.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O Williams whose telephone number is 703-305-3312. The examiner can normally be reached on 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JW

Jacob K. Ackun
Primary Examiner